

10-27-04

1635 #  
Hm



Attorney's Docket No. 3477-95

PATENT

IN THE UNITED STATES DESIGNATED OFFICE (DO/US)

In re: Aubin et al.

Group Art Unit: 1635

Serial No.: 10/089,429

Examiner: J.E. Aubin

International Filing Date: August 30, 2000

Confirmation No. 6914

For: *ESTROGEN RELATED RECEPTOR  $ERR\alpha$ ,  
A REGULATOR OF BONE FORMATION*

Date: October 26, 2004

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

### Response to Restriction Requirement

In response to the Restriction Requirement dated July 14, 2004, Applicants elect the claim of Group V (claim 2; drawn to a method of increasing differentiation of osteoblasts by administering an  $ERR\alpha$  agonist) with traverse, as Applicants respectfully submit that it would not be an undue burden to examine all of the claims concurrently. In particular, it would not be an undue burden to search and examine the entire scope of claim 2 (*i.e.*, Groups V to VIII). Further, the Restriction Requirement allegedly utilizes the unity of invention criteria of PCT Rule 13.1; however, no restriction for lack of unity of invention was issued during the international stage, whereas the present Restriction Requirement is quite onerous and places an unreasonable burden on the Applicants as it requires the Applicants to file at least 35 separate applications to pursue the subject matter of the originally filed 15 claims.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding Restriction Requirement.

This application is in condition for substantive examination, which action is respectfully requested.

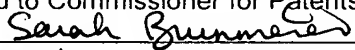
Respectfully submitted,

Karen A. Magri  
Registration No. 41,965

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**CERTIFICATE OF EXPRESS MAILING**

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